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Supreme Court, U.S.
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In the Supreme Court of the United States

MINKA LIGHTING, INC.,

Petitioner,

v.

CRAFTMADE INTERNATIONAL, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* INDUSTRIAL DESIGNERS SOCIETY OF AMERICA IN SUPPORT OF PETITIONER

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INTEREST OF THE *AMICUS CURIAE*[1]

As the leading organization in the field of industrial design, the Industrial Designers Society of America ("IDSA") and its over 3,300 members are adversely affected by the lower court's decision in *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, 2004 U.S. App. LEXIS 770 (Fed. Cir., unpub., 2004). The *Minka* decision weakens the ability of industrial designers to enforce their design patents against infringers and facilitates the ease of copying patented designs which threatens the industrial design community as a whole.

According to the Bureau of Labor Statistics, there are presently about 35,000 people who claim to work as industrial designers in the United States.

It is estimated that IDSA members are named in over 15,000 design patents. The breadth of protection afforded to these patents is of great concern to the IDSA, which has led it to step forward and address the threat posed to its members through the *Minka* decision.

CONSENT TO FILING

In accordance with Supreme Court Rule 37.2(a), IDSA has obtained written consent to the filing of this *amicus curiae* brief from the counsel of record for all parties. The letters of consent have been filed separately with the Clerk of the Court.

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[1] Pursuant to Supreme Court Rule 37.6, *amicus curiae* states that this brief was not authored, in whole or in part, by counsel to any party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the *amicus curiae* or its counsel.

SUMMARY OF THE ARGUMENT

The decision below reveals the dilemma that has faced members of the design community since 1996 when the Court decided *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). The first and foremost test for design patent infringement has always been the "ordinary observer" test set forth in this Court's 1871 decision *Gorham Co. v. White*, 81 U.S. (14 Wall) 511 (1871).[2] By instructing courts to adopt the view of the "ordinary observer," not an expert, when visually comparing the design illustrated in a design patent with an accused design, the *Gorham* test incorporates a broad view of design patent claims. *See id.* at 528. Since *Markman*, however, courts have been required as a matter of law to determine the meaning and scope of patent claims. In the context of design patents, courts have been forced to express the visual images of design patent drawings in words, i.e., to verbalize the designs. Consequently, instead of comparing the *actual* design shown in the patent drawings with the accused design,[3] courts and juries are increasingly comparing the latter

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[2] After the *Gorham* test is satisfied, the second or "point of novelty" test for design patent infringement must also be satisfied in order for infringement to be found, namely, "the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art." *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 434 (Fed. Cir. 1984).

[3] Courts have long held that infringement is determined by a comparison of the design patent drawings and the accused product, unless the product sold by the patentee is substantially the same as that shown in the patent drawings, in which case the patentee's product can be compared with the accused product. *See L.A. Gear Inc. v. Thom McAn Shoe Co.*, 25 USPQ2d 1913, 1919 (Fed. Cir. 1993); *See also Lee v. Dayton-Hudson*, 5 USPQ2d 1625, 1627 (Fed. Cir. 1988).

with the *Markman*-mandated *verbalization* of the claimed design. This comparison has resulted in an unintended but deadly literal test for design patent infringement, in which courts determine whether the accused design has all of the elements verbalized in the *Markman* claim construction. Such a narrow view of design patents leaves no room for the perspective of the "ordinary observer" or for the equivalents within the purview of an ordinary observer.

If the Court's intent in *Markman* (a utility patent case) was to overrule the long-standing *Gorham* "ordinary observer" test for design patent infringement, this must be explicitly stated. If overruling *Gorham* was not the Court's intent, then lower courts are misapplying *Markman* in the design patent context and the Court should correct this by clarifying that *Markman* does not apply to design patent claims, i.e., a court should not waste its time verbalizing an illustrated design.

If the Court fails to act, the "ordinary observer" test of *Gorham* will continue to die a slow death, as is evidenced by the decision below, leaving in its wake designers unable to rely on their design patent claims for protection against infringers and courts wasting enormous resources in the futile struggle to verbalize visual designs.

REASONS FOR GRANTING THE PETITION

1. This Court held in *Gorham Co. v. White* that the "ordinary observer" test for infringement incorporates a broad interpretation of design patent claims.

In 1871, the Supreme Court established the following test for design patent infringement in *Gorham Co. v. White*:

We hold therefore, that if, in the eye of an ordinary

> observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an ordinary observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. 81 U.S. at 528.

The patented and accused designs in *Gorham* were both silverware handle designs, as can be seen in App. 1a. The defendant, White, relied upon the testimony of numerous expert witnesses to establish the differences between the two designs, but ultimately this testimony fell on deaf ears.

According to the Court, if design patent infringement was judged through the eyes of an expert designer "there could never be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them." *Id.* at 527. Therefore, the Court reasoned that a design patent would be meaningless because no matter how similar two designs are, experts with a high degree of discernment will see differences in the designs that ordinary people will not. Fortunately, the Court saved designers from such a fate by determining that infringement was to be judged from the perspective of an ordinary observer, not an expert.

The "ordinary observer" test includes a test for equivalents, since it was understood that literal design patent infringement almost never happens. The Court defined identity of design as "sameness of appearance." *See id.* at 526. This concept of sameness allowed for equivalents, for as the Court explained "mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect on the eye, *will not destroy the substantial identity* [between the two designs]." *Id.* at 526-7.

Here is how the court framed the doctrine of equivalents for designs: "Is the adornment in the White design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the prior patent, amounting at most to a mere equivalent?" *Id.* at 530.

Although still the law of the land, the effect, purpose and intent of *Gorham* has been significantly eroded by the decision below, and others like it, that require verbalization of the meaning of a design patent claim before applying the *Gorham* infringement test.

2. This Court's decision in *Markman* is forcing courts to narrowly construe design patent claims.

a. The *Markman* Mandate

In 1996, the Court decided *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), which required courts to interpret the meaning and scope of patent claims as a matter of law before applying the test for infringement. The focus of *Markman* was the language in the claims of a *utility* patent,[4] specifically, the meaning of the word "inventory". Design patents were neither involved nor discussed in *Markman*.

Although *Markman* did not speak to design patents, the Federal Circuit in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 36 USPQ2d 1417 (Fed. Cir. 1995), improvidently

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[4] Essentially, a utility patent protects the way a product functions without regard to how it looks, while a design patent protects the way a product looks without regard to how it functions. 35 USC § 101; 35 USC § 171.

extended the *Markman* rule to design patents by stating the following two-part test for design patent infringement:

> "Determining whether a design patent claim has been infringed requires, first, as with utility patents, that the claim be properly construed to determine its meaning and scope. (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995)). Second, the claim as properly construed must be compared to the accused design to determine whether there has been infringement." *Elmer*, 36 USPQ2d at 1420.[5]

This created a conundrum: each design patent has but a single claim that appears in a standard format and refers to the design "as shown" in the design patent drawings.[6] There is never language in the design patent claim itself that requires interpretation. Since it is settled law that the claimed design is manifested in the design patent drawings,[7] the Federal Circuit found it necessary to require lower courts to render *Markman* determinations of design patents by putting into words the visual appearance of the designs shown in the patent's drawings, i.e., by verbalizing the designs. As is evident from the decision below and case law to be discussed herein, the requirement for converting visual images into words not only wastes enormous court resources[8], but more importantly has

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[5] *Elmer* relied upon the Federal Circuit *Markman* decision of 1995, not the 1996 Supreme Court decision affirming the Federal Circuit's ruling.

[6] The single claim in the decision below is "The ornamental design for a combined ceiling fan and light, as shown."

[7] Manual of Patent Examining Procedure (M.P.E.P), §1503.01 [May, 2004].

[8] In *Puritan-Bennett Corp. v. Penox Technologies, Inc.*, discussed later in this brief, the district court devoted fifteen pages to determining the verbalization of the claimed design. 2003 US Dist.

eviscerated the *Gorham* test that relies upon a comparison, from the perspective of the "ordinary observer," of the accused design with the design shown in the patent drawings.[9]

b. Pre-*Markman* and Post-*Markman* Federal Circuit cases reveal the impact of the *Markman* decision on the *Gorham* "ordinary observer" test.

The impact of *Markman* on design patent infringement is most evident from a comparison of two decisions from the Court of Appeals for the Federal Circuit: the pre-*Markman* decision in *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121 (Fed. Cir. 1992), and the post-*Markman* decision in *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 43 USPQ2d 1641 (Fed. Cir. 1997). In both cases, the patented design and accused designs were much closer to each other in appearance than either design was to the prior art, as is evident from Apps. 2a and 3a.

In *Braun*, the Federal Circuit acknowledged this closeness stating: "...in contrast to pre-existing [prior art] hand held blenders, which had a utilitarian, mechanical appearance, both Waring's blender and Braun's blender share a fluid, ornamental, aerodynamic overall design." *Braun*, 24 USPQ2d at 1125. Despite the differences between the Braun and Waring designs, evident from App. 2a (most notably the handle indentation present in the Braun blender and absent from the Waring blender), the court affirmed a jury finding of infringement under *Gorham*.

LEXIS 21822, *17-32 (S.D.Ind. 2003).

[9] *See L.A. Gear*, 25 USPQ2d 1913 and *Lee*, 5 USPQ2d 1625, discussed above in note 3.

In contrast to *Braun*, the Federal Circuit in a post-*Markman* case affirmed a lower court finding of non-infringement in *OddzOn*, although the two designs were, again, much closer to each other than either was to the prior art, as can be seen from App. 3a. The Federal Circuit affirmed the district court's *Markman*-mandated verbalized "claim construction" which read as follows:

> "...a ball shaped like a football, with a slender, straight tailshaft projecting from the rear of the football. In addition, the '001 Patent design has three fins symmetrically arranged around *the tailshaft*, each of which has a *gentle curve* up and outward which creates a fin with a larger surface area at the end furthest from the ball. The fins flare outwardly along the entire length of the tailshaft, with the front end of the fin extending slightly up along the side of the football so that the fins *seemingly protrude from the inside of the football*." *OddzOn*, 43 USPQ2d at 1643 (emphasis added).

It was not difficult for the district court to grant defendant's motion for summary judgment based on its view that this *Markman* claim construction did not read onto the accused design due to minor differences between the two designs that, not concidentally, were part of the "claim construction" (e.g., the absence in the accused design of the gentle curve on the tailshaft, and the seeming protrusion of the fins from inside the football). Although the Federal Circuit quoted the *Gorham* test in its affirmance of the district court decision, its reliance on the lower court's claim construction prevented it from visually comparing the designs, as has long been traditionally

mandated by *Gorham*.[10]

The *OddzOn* case is a clear example of how the *Markman* "claim construction" requirement has the unintended effect of removing the question of design patent infringement from the jury and encouraging courts to engage in literal infringement analysis by ignoring the possibility of equivalents under *Gorham*. Based on App. 3a, it is easy to appreciate that the accused design is much closer to the claimed design than either is to the prior art, which should have resulted in a broader scope of protection than was found by the court. Had the fact-finder been able to do its proper job, visually determining whether the two designs were substantially the same in the eyes of an ordinary observer without any preconceived verbalized claim construction, it is quite possible that it would have returned a verdict of infringement, given the closeness in overall appearance of the two designs, and the striking contrast of both when compared to the prior art as in *Braun*.

On the other hand, it is equally clear that had the lower court in *Braun* been required to engage in "claim construction", it would very likely have verbalized the handle indentation of the design as part of the claimed design. The jury would then have been instructed that the scope of the design patent includes an indented handle as a matter of law, which in turn would have led to a finding of non-infringement. Obviously, this would have eviscerated the *Gorham* test, an unintended result of applying *Markman* to design patents.

c. In the decision below, the Federal Circuit misapplied the "ordinary observer" test and narrowed Petitioner's design patent claim.

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[10] *See L.A. Gear*, 25 USPQ2d 1913 and *Lee*, 5 USPQ2d 1625, discussed above in note 3.

In *dicta*, the decision below suggested that courts are still actually applying the *Gorham* test, instead of simply citing it. However, the court's ultimate decision reflected that it did not accurately apply the *Gorham* test. *Minka Lighting, Inc. v. Craftmade Int'l., Inc.*, 2004 U.S. App. LEXIS 770 (Fed. Cir., unpub., 2004). This case reached the Federal Circuit after the district court in Dallas granted summary judgment of non-infringement based on relatively minor differences between a patented ceiling fan design and the accused design[11] presented in App. 4a.

Before analyzing the Federal Circuit decision, it is necessary to take a look at the district court's *Markman* claim construction for the design patent drawings because it is this verbalized design that determined the ultimate outcome of non-infringement and represents the underlying problem that this Court must address. Although the district court claimed to base its decision on a "visual comparison" of the fan designs, and the Federal Circuit upheld the court's right to do so, the fact remains that the district court did not engage in a "visual comparison" of the designs. *See Minka Lighting, Inc. v. Craftmade Int'l., Inc.*, 2002 U.S. Dist. LEXIS 8693, *13 (N.D. Texas May 15, 2002). Rather, the court compared the *Markman*-mandated verbalization of the design patent drawings with the accused design. *See id.* If the district court had not been forced to verbalize the design patent drawings, it would not likely have viewed Petitioner's patent claim so narrowly or returned a judgment based essentially on unheard of literal design patent infringement.

The district court's claim construction for the design patent

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[11] The Solo fan is one of the two accused devices found non-infringing in this case.

not only displays the waste of resources devoted to verbalizing design patent drawings, but also reveals the court's misreading of *Gorham.*[12] In its visual comparison of the designs and eventual finding of non-infringement, the district court quoted *verbatim* from the design elements it had just verbalized in its *Markman* claim construction. For example, the court found that the blades in the accused fan design did not create the same "sweeping curve" as the Petitioner's blades, did not have the "elongated football-shaped cut outs" or the "gently receding arc in front of each bracket arm's leading edge [which] runs from the tip of each arm to the middle of the smooth transition" that was "contemplated" by Petitioner's design. *Id.* at *13. This form of detailed comparison based on the verbalized design is clearly not a comparison through the eyes of the "ordinary observer" as mandated by *Gorham.*

In reviewing the district court's decision, the Federal Circuit correctly emphasized that the focus of the infringement analysis is a visual comparison between the design patent drawings and the accused design, but did not call the district court to task for failing to make just such a comparison. The Federal Circuit sounded an encouraging note for the "ordinary observer test" when it wrote that "a verbal description of the drawings does not necessarily aid such a comparison." 2004 U.S. App. LEXIS 770, at *4. It then went on, however, to say that there are some instances when an "extensive verbal claim construction" could be of some use. *See id.* Examples of this include when "the drawings contain features that are not part of the patented design, e.g. if the drawings contain functional features or if there is a point of novelty to consider." *Id.*

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[12] For a detailed description of the court's verbalized claim construction, see *Minka,* 2002 U.S. Dist. LEXIS 8693 at *7-9.

Indeed, if all a court did in response to *Markman* was to either identify functional features[13] and/or the point of novelty,[14] the verbalization might be of some use in the case. But by and large that is not what is actually happening, as is evident below, and at least one court has flatly stated that identification of functional features and the point of novelty are questions of fact for the jury.[15]

The fans at issue in *Minka* are no more visually different from each other than the silverware in *Gorham* or the blenders in *Braun*, yet the decision below is one of non-infringement. The only thing that has changed over time is the misguided verbalization requirement imposed by *Markman*. It is not surprising that Petitioner is arguing for the allowance of empirical evidence representing the opinions of ordinary purchasers – such a request can be viewed as an attempt to revive the "ordinary observer" standard that has been silenced by the verbalization requirement of *Markman*. The allowance of empirical evidence, although perhaps helpful, will not necessarily solve the underlying problem. The compelling solution is to release courts from the obligation of verbalizing design patent claims under *Markman* so that the ultimate "visual comparison" mandated by Gorham actually reflects the view of the "ordinary observer" and includes equivalents.

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[13] "If...a design contains both functional and ornamental features, the patentee must show that the perceived similarity is based on the ornamental features of the design." *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825 (Fed. Cir. 1992).

[14] The "point of novelty" of the patented design must be found in the accused design to satisfy the second step of design patent infringement. See footnote 2.

[15] *See Black & Decker Inc. v. Pro-Tech Power Inc.*, 1998 U.S. Dist. LEXIS 9162, 47 USPQ2d (BNA) 1843 (E.D.V.A. June 2, 1998), discussed below.

d. District Court decisions reveal that tension between *Gorham* and *Markman* extends beyond the scope of the present case and is dividing the courts.

Three examples from district courts show how the tendency to ignore *Gorham* is not just limited to the Federal Circuit or to the decision below. In addition, at least one district court has eloquently expressed the inapplicability of *Markman* to design patent cases, indicating a genuine division amongst the courts on how to handle the conflict between *Gorham* and *Markman*.

In *Puritan-Bennett Corp. v. Penox Technologies, Inc.*, 2003 U.S. Dist. LEXIS 21822 (S.D. Ind. Dec. 4, 2003) the District Court of the Southern District of Indiana verbalized the claim represented by the design patent drawings for a portable gas dispenser, as seen in Apps. 5a and 6a.

The district court's claim construction, while detailed and verbose (itself taking up almost three pages in the decision), resulted in a fairly narrow verbalization of the claimed design. For example, the court identified in Figure 3 of the design patent what it called "the most striking feature" of the patented design, namely, "a center Roman arch...at the top and center of which sites a rather large dial. In addition, a rather thick, squared, solid handle...forms a rectangular arch over the center Roman arch...The rather large dial...has a center hour-glassed shaped flange...[There is a] column of horizontal vents [on two] partial arches." *Id.* at *29. As for the bottom view represented in Figure 8 of the design patent, the court noted "the footprint of the design...is shaped like [the] profile of a Volkswagen Beetle or 'Bug.'" *Id.* at *30.

It is no surprise that after articulating such a detailed list of design features contained in the patent drawings, the court was able to point to differences between its detailed list and the

accused design, as seen in Apps. 5a and 6a.

Although the court cited the *Gorham* test to support the statement that designs "need not be identical to find infringement," it still subsequently issued a finding of non-infringement for two designs that appear at least as similar as the designs in *Gorham*. *Puritan-Bennett Corp. v. Penox Technologies, Inc.*, 2004 U.S. Dist. LEXIS 6896, *59 (S.D. Ind. March 2, 2004). In granting the defendant's motion for summary judgment of non-infringement, the court found "stark" differences between the accused design and the patented design "as depicted in the drawings *and construed by the court.*" *Id.* at *71 (emphasis added). As in *Minka*, the court quoted at length from its own verbalized claim construction and checked to see if the accused design had the elements included in the verbalization – hardly a "visual comparison" under the "ordinary observer" test of *Gorham*. See *id.* at *71-73. A true visual comparison suggests that the differences between the designs are not in fact "stark" as the court observed, but could indeed fall within the range of equivalents allowed by *Gorham*. This case is further evidence that the venerated *Gorham* test is under attack.

Likewise, in *Tecumseh Products Co. v. Briggs & Stratton Corp.*, 2003 U.S. Dist. LEXIS 22125 (E.D. Wis. Dec. 5, 2003), a district court's *Markman* ruling restricted the scope of the design patent to the solid line details shown in the patent drawings. After verbalizing in detail such solid line ornamental features found in the patented design, the court then embarked on what it called "the second step of the patent infringement analysis, i.e., *compare the construed claim to the accused device... under the 'ordinary observer' test.*" *Id.* at *14 (emphasis added). However, a comparison between the "construed claim" and the accused design is <u>not</u> the "ordinary observer" test, but rather a narrow test for unheard of literal

design patent infringement, the harmful effects of which are evident from the court's decision. The court concluded that "precisely-drawn ornamental features of the various external components [of the patent] *must be considered in determining whether a reasonable trier of fact...could find the Aero's overall appearance to be substantially similar to the patented design.*" *Id.* at *37 (emphasis added). This is a direct example of a court improperly using the verbalized *Markman* determination in the infringement analysis, which is supposed to be determined through the eyes of an "ordinary observer" rather than the court.

Further evidence that the "ordinary observer" test was not used in *Tecumseh* is found in a comparison of the patented design and the accused design, as can be seen in App. 7a. When viewed in light of *Gorham Co. v. White*, the similarity in appearance between the two designs above certainly presents a triable issue of fact. Unfortunately, the court's vision was so restricted by the verbalization requirement of *Markman* that it could not see the similarity that is apparent to even the most ordinary of observers.

One district court has refused to verbalize design patent drawings and suggests that *Markman* does not apply in the design context. *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 1998 U.S. Dist. LEXIS 9162, at *7, 47 USPQ2d (BNA) 1843, 1845 (E.D.V.A. June 2, 1998). In *Black & Decker,* the district court agreed with the patent holder's argument that "the [patent] illustration is its own best description" and found that the scope of the patent was its "'overall ornamental visual impression' as shown in the six orthogonal drawings." *See id., See id.* at *17. In addition, the court refused to determine the functional features or the "point of novelty" embodied in the design patent drawings, leaving these questions for the jury. In its final ruling, the court restated the scope of the design

patent as the "'overall visual impression' created by the drawings" and issued a finding of infringement. *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 1998 U.S. Dist. LEXIS 18252, at *58 (E.D.V.A. Nov. 16, 1998). The court's interpretation of *Markman* is discussed later in this brief, but the case is mentioned here to show that there exists a dissenting voice amongst the district courts regarding the proper role of *Markman* in design patent cases.

e. The Jury Problem: How to use the claim construction without reverting to literal infringement.

Not only is the *Markman* ruling problematic in that it encourages courts to narrowly interpret a design patent claim, but it also places these claim verbalizations before a jury that may have no other choice but to consult them in determining infringement. The jury thus returns a decision based on literal infringement without even realizing it. The question of how the jury should handle court ordered claim constructions was somewhat confusingly addressed by the North District of Texas in *Lamps Plus, Inc. v. Dolan,* 2003 U.S. Dist. LEXIS 19578 (N.D. Texas 2003).

In *Lamps Plus*, the court correctly identified its role in design patent claim construction, but was confused in its explanation of how the jury should handle the verbalization information. According to the court, its role in claim construction, as mandated by the Federal Circuit, is "to provide a description that evokes the visual appearance of the ornamental features of a patented design." *Id.* at *12 (quoting *Minka*, 2001 U.S. Dist. LEXIS 14199, at *19). The court appeared to be on the right track when it stated that such description should "*assist* the jury in its task of comparing the design patent with the accused product, but not *require* the jury

to compare the Court's description to the accused product." *Id.* (emphasis added). However, the court left unexplained just how it expected the jury to consult the verbalized claim construction but not use it to read onto the accused design, especially when the court said that the verbalized claim construction "is sufficient to assist the jury in understanding the *legal effect* of the patented design." *Id.* at *12-13. There is no escaping the conclusion that this *legal effect* results in a literal "picture" claim, virtually eliminating equivalents and banishing Gorham to the dust bin.

3. Markman should not apply to design patent cases.

Markman determinations should not be required in the design patent context. While the harm *Markman* has caused to the venerated *Gorham* test is one reason for this, the rationale underlying the *Markman* decision provides yet another strong argument for restricting the case to the non-design patent world from which it came.

The most obvious indicator that *Markman* should not apply to design patent claims is that the decision was only concerned with interpreting the text of utility patent claims. In fact, the proper definition of one word used in the patent claims, "inventory," was central to the decision. This scenario would never appear in the design patent context. The Supreme Court noted that victory in an infringement suit "necessitates a determination of 'what the *words* in the claim mean.'" *Markman*, 517 U.S. at 374 (citation omitted). While true enough for utility patent infringement, before *Markman* this statement was never true for design patent infringement. It is not true now.

After establishing the importance of textual interpretation in utility patent infringement, the Court next placed this task

squarely at the feet of the courts, not the jury. The reasoning behind this act was simple, as set forth in the Federal Circuit decision in *Markman*: "it has long been and continues to be a fundamental principle of American law that 'the construction of written evidence is exclusively with the court.'" *Markman*, 52 F.3d at 978 (citations omitted).

While giving courts the role of interpreting utility patent claims may make sense when claims consist of words, this logic does not apply to design patent claims, which by definition simply refer to the design as shown in the patent drawings. This inconsistent logic has not gone unnoticed by the federal bench. One district court decision cogently observed that "the rationale behind the decision in *Markman* simply does not apply to making determinations regarding functionality or 'points of novelty' in the design patent context. Because design patents consist of pictures, and not words, the Court's experience with 'document construction' and 'standard construction rules' regarding terms contained in a document, are not of help in the design patent context."[16] *Black & Decker*, 1998 U.S. Dist. LEXIS 9162, at *9-10.

The emphasis on public notice and the danger of a "zone of uncertainty" expressed by the Supreme Court in *Markman* is also inapplicable to design patents. Granted, the public needs to know the scope of a patent in order to avoid infringing activities, but what better notice is there than the actual drawings of the patented design? When an enterprising designer checks to see whether her design infringes an existing

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[16] In addition to refusing to verbalize the design patent claim, the court in *Black & Decker* also refrained from determining the functional elements and points of novelty of the claimed design, stating that these questions of fact properly belonged to the jury. *See id.* at *17.

design patent, all that is necessary is for her to look at drawings of the patented design. This is in contrast to an inventor, who must understand the function and structure of the invention covered by a utility patent, which can only be represented by words that are inevitably capable of various meanings.

If there was uncertainty as to the scope of design patents before *Markman*, asking courts to verbalize a design patent claim does not bring clarity to this issue. Even the most verbose of courts cannot possibly do justice to a single design image, for as the saying goes, "a picture is worth a thousand words." Once a court begins to verbalize a design it sacrifices the visual appearance of the design patent as found in the drawings for one of a multitude of possible verbal interpretations of the drawings. It is undeniable that no two courts would chose the same words to verbalize a design, especially given the fact that courts often use subjective, aesthetic terms to describe the designs. Considering the Supreme Court's concern in *Markman* about uncertainty surrounding the scope of patent claims, it seems illogical for the Court to encourage more uncertainty by requiring courts to verbalize design patent claims, especially when the clarity they seek is visually before the courts in the design patent drawings. *Markman* would be better served if it directed courts to simply view the design patent drawings, rather than usurp them.

The task of verbalizing a design patent claim is at best redundant (why tell the eye what it sees?) and at worst impossible (can words truly capture a visual impression?), but either way it is clearly a waste of judicial resources and a distraction from more important matters facing the courts.

CONCLUSION

Markman as applied to design patents is encouraging courts to abandon *Gorham Co. v. White* along with its "ordinary observer" test and doctrine of equivalents. Also being left behind is any possibility of reasonable design patent claim scope embodied in the *Gorham* decision and pre-*Markman* cases such as *Braun*. The decision below is a clear example of the patent holder's struggle, either through empirical evidence or other means, to uphold the *Gorham* test by reinserting the view of the "ordinary observer" back into the infringement equation. Design patent holders should not be forced to adopt such measures. The Court can clear the path for the reemergence of the "ordinary observer" and reasonable design patent equivalents by removing the obstacle posed by *Markman*. Doing so will also end the waste of resources that lower courts are putting into the futile enterprise of determining the "meaning" of a visual design patent claim.

Furthermore, *Markman* never should have been applied to design patent cases, as is evident from the problems the decision has caused in the field of design patent law. The differences between design and utility patents are often overlooked, and unfortunately the Supreme Court and Federal Circuit fell prey to this in both *Markman* decisions. Since it now appears that these decisions have placed the breadth of patent rights afforded to design patent holders at risk, and has mortally wounded the 1871 *Gorham* case, it is time for the Court to acknowledge that a *design* patent is different from a *utility* patent, and finally relieve design patent owners from the stranglehold of *Markman*.

For the reasons set forth in this *amicus curiae* brief, the IDSA respectfully urges the Supreme Court grant the Petition for a Writ of *Certiorari*.

Respectfully submitted,

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